



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,870	01/05/2004	Takeshi Satoh	57454-994	3233

7590 06/03/2005

McDermott, Will & Emery
600 13th Street, N.W
Washington, DC 20005-3096

EXAMINER

JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
----------	--------------

1754

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,870

Applicant(s)

SATO ET AL.

Examiner

Edward M. Johnson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1754

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-4, in the reply filed on 5/11/05 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahata et al. US 6,284,690 in view of Kato et al. US 5,603,877.

Regarding claim 1, Nakahata '690 discloses a method of making porous Si_3N_4 comprising mixing a sintering aid (abstract) comprising 0.5-17% of a rare earth element (see column 3, lines 39-42); adding binder; molding (column 2, lines 32-35); heating

Art Unit: 1754

at 200-800 degrees C (see column 1, lines 64-66) removing the binder (see column 4, lines 38-41); then nitriding and sintering by raising the temperature from 800 to 1800 in the nitrogen atmosphere (see column 5, lines 30-33).

Nakahata fails to disclose a pressure of 0.1-1 atmosphere.

Kato '877 discloses a sintering pressure of at least 0.1 or 5-20 atmG.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pressure of at least 0.1 or 5-20 atmG of Kato in the silicon nitride sintering process of Nakahata because Kato discloses the sintering pressure in a sintering process for making silicon nitride (see title, abstract) to obtain "a denser ceramic structure" (see column 4, lines 50-52), and also because Nakahata '690 discloses heating in a "nitrogen atmosphere" (see Example 1), which would obviously, to one of ordinary skill, at least suggest an ambient pressure of one atmosphere.

Regarding claim 2, Nakahata '690 discloses composite compounds containing "at least one of" rare earth and Group II compounds (see column 3, lines 25-35).

Regarding claims 3-4, Kato '877 discloses a sintering pressure of at least 0.1 or 5-20 atmG.

Conclusion

Art Unit: 1754

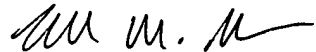
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huckabee et al. US 5,047,186 discloses a process for producing silicon nitride comprising mixing sintering agent and binder, removing binder, and sintering under pressure (see abstract, Examples, and column 3, lines 63-68); Oda et al. US 5,804,523 discloses a method for making silicon nitride comprising mixing sintering agent and binder, removing binder, drying, and sintering under pressure (see abstract, Examples, and column 5, lines 5-15).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edward M. Johnson
Examiner
Art Unit 1754

EMJ